

Appl. No. 10/635,779

Amendt. dated July 14, 2005

Reply to Final Office Action of May 17, 2005

REMARKS / ARGUMENTS

Attached to this Amendment is a "Declaration Under Rule 1.132" to establish that an invention disclosed but not claimed in a reference cited by the Examiner in a 35 U.S.C. Sec. 102(e) rejection was derived from an inventor of the present application, and to thereby resolve the concern of the Examiner and remove the rejection. The present amendment of claim 1 only removes language added by the applicants' Amendment of March 16, 2005, thereby returning the only remaining independent claim to its original wording. Therefore, reconsideration and allowance of the specification and amended and pending claims are hereby requested.

I. INVENTION OVERVIEW

The invention is a hydrogen passivation shut down system for a fuel cell power plant. An anode flow path is in fluid communication with an anode catalyst for directing hydrogen fuel to flow adjacent to the anode catalyst, and a cathode flow path is in fluid communication with a cathode catalyst for directing an oxidant to flow adjacent to the cathode catalyst of a fuel cell. A hydrogen reservoir is secured in fluid communication with the anode flow path for receiving and storing hydrogen during fuel cell operation.

Upon shut down of the plant, a hydrogen transfer valve is opened to selectively permit hydrogen fuel to transfer between the anode flow path and the cathode flow path. Also upon shut down, the hydrogen reservoir releases the stored hydrogen into the fuel cell

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and after a hydrogen inlet valve prohibits flow of hydrogen fuel into the anode flow path from a hydrogen fuel source, the hydrogen reservoir continues to release hydrogen into the anode flow path and through the hydrogen transfer valve into the cathode flow field. Maintaining hydrogen within the anode and cathode flow paths during shut down of the plant minimizes oxidation of fuel cell components.

II. RESPONSE TO OFFICE ACTION

In the Final Office Action of May 17, 2005, the Examiner has removed his 35 U.S.C. 112 second paragraph rejection of claim 15 and acknowledged cancellation of claims 17 27, but has sustained his rejection of the only pending independent claim, claim 1, and claims 2, 7, 9, 13 and 16 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,838,199 to Balliet et al.

In Section 6 of the Final Office Action, the Examiner has stated that the rejection might be overcome by a "showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not 'by another'...." Attached to this Amendment as Exhibit A is a "Declaration Under Rule 1.132" signed by inventor Ryan J. Balliet et al. that makes that showing. The Declaration also includes compelling evidence in an attached "Invention Disclosure" document that supports the assertions of the Declarant. Pursuant to the "Manual of Patent Examining Procedure" ("M.P.E.P.") Section 716.10, third para. the attached Declaration presents an "uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in [U.S. Patent 6,838,199]...."

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Therefore, the Declaration should be "accepted as establishing inventorship." (Id. at Sec. 716.10, third para.) Additionally, the Declaration establishes a showing that the inventorship of the present, above referenced application is correct because the Declaration shows that the specific subject matter described in the Declaration and that is disclosed but not claimed in the reference '199 Patent to Balliet et al. is subject matter derived from the Declarant Ryan J. Balliet alone, and not invented by the other inventors of the reference. For the same reason, the Declaration also establishes at paragraph 5 that the subject matter described in the Declaration and disclosed but not claimed in the Balliet et al. reference, but which is now claimed in the present, above referenced application, was invented by the Declarant Ryan J. Balliet alone and not by the other joint inventors of the present, above referenced application.

With respect to the contributions of the other joint inventors of the Balliet et al. '199 reference, it is pointed out that: "Disclaimer by the other patentee[s] ... of the [reference patent] should not be required...." (M.P.E.P. at 716.10, first para.)

Consequently it is urged that Balliet et al. be removed as a reference because the Declaration establishes the disclosed subject matter of the reference is not the invention "of another". Removing Balliet et al. as a reference will resolve the Examiner's Section 102(e) basis for rejection of the only pending independent claim, claim 1, and dependent claims 2, 7, 9, 13 and 16.

At sections 8 - 13 of the Final Office Action, the Examiner has

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rejected claims 3-5 under 35 U.S.C. 103(a) as being obvious over the '199 Balliet et al. reference in light of U.S. Patent No. 6,589,312 to Snow et al. It is respectfully urged that because Balliet et al. should be removed as a reference for the reasons recited above regarding the "Rule 1.132" Declaration, the Examiner's rejection of claims 3-5 on Balliet et al. in combination with Snow et al. should also be removed. Additionally and alternatively, the Examiner's rejection of claims 3-5 should be removed for a separate reason. Independent claim 1 is now believed to be allowable. Therefore, dependent claims 3-5 simply further limit independent claim 1, and therefore must be allowable if independent claim 1 is allowable.

At sections 14 - 18 of the Final Office Action, the Examiner has rejected claim 14 as being obvious over the Balliet et al. '199 reference in view of U.S. Patent 6,635,370 to Condit et al. The undersigned reiterates the two arguments recited above with respect to claims 3-5 as to this rejection of claim 14. Because Balliet et al. should be removed as a reference, this section 103 combination rejection should likewise be removed, and separately, claim 14 depends from now allowable claim 1, and hence should be allowable as further limiting an allowable independent claim.

Because applicants have established by the attached "Declaration Under Rule 1.132" that Balliet et al. is not the invention of another and therefore should be removed as a reference, independent claim 1 has been amended to remove the clarifying language added by the March 16, 2005 Amendment. Consequently, the present amendment to claim 1 returns claim 1 to its original wording.

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III. CONCLUSION

Therefore, by the present Amendment, the Application is believed to have been placed in condition for allowance. Accordingly, it is respectfully requested that a Notice of Allowance be issued.

Respectfully submitted,
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